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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,117	04/02/2001	David W. Boyd	10003824-1	9177

7590 05/13/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

AL HASHEMI, SANA A

ART UNIT PAPER NUMBER

2171

DATE MAILED: 05/13/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/824,117

Applicant(s)

BOYD ET AL.

Examiner

Sana Al-Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-45 is/are pending in the application.
- 4a) Of the above claim(s) 46-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

**Claim Status: 33-45 rejected and 46-52 withdrawn from consideration.**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/2/2003 has been entered.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 33- 45, drawn to a generating database, classified in class 707, subclass 102.
- II. Claims 46-52 drawn to printing images, classified in class 707, subclass 104.1.

Inventions I, and II are related as combination and subcombination respectively.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particular subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (I) as claimed generating database system does not require the image printing system as claimed in subcombination (II). Subcombination (II) the method image printing system as claimed has separate utility by itself or in other combination does not require the particular combination as claimed in combination (I) of generating a database for patentability. Therefore, the inventions are distinct; however, they could be usable together.

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2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for I is not required for II, respectively, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 46-52 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No.

During a telephone conversation with Michael A. Papalas April 6, 2004 a provisional election was made with traverse to prosecute the invention of I, claims 33-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 46-52 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected inventions.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33-38, 40-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et al. (US Patent 6,483,570).

1. Regarding Claim 33, Slater discloses a method comprising:

providing a plurality of images (see column 5, lines 52-55, Slater);

providing information associated with at least one image of the plurality of images and storing the information in a database (see column 5, lines 55-67, Slater);

generating a label having an identifier, wherein the label is adapted to be affixed to a storage device that is adapted to hold printed copies of the plurality of images (see column 6, lines 1-8, Slater); and

associating, in the database, each image of the plurality of images with the identifier (see column 6, lines 15-20, Slater).

2. Regarding Claim 34, Slater discloses a method further comprising:

storing each image of the plurality of images in the database (see column 7, lines 30-37, Slater);

3. Regarding Claims 35, and 44, Slater discloses a method wherein providing information comprises:

forming metadata during formation of the at least one image(see column 7, lines 51-54, Slater).

4. Regarding Claim 36, Slater discloses a method wherein providing information comprises:

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inputting, by a user, the information (see column 10, lines 19-27, Slater).

5. Regarding Claims 37, and 43, Slater discloses a method wherein the information is at least one of:

GPS coordinates;

a time;

a date;

camera information;

an audio file;

at least one keyword;

a description of subject matter of the image (see column 15, lines 1-6, Slater); and

an event associated with the image (see column 6, lines 1-10, Slater).

6. Regarding Claims 38, Slater discloses a method wherein the storage device is selected from the group consisting of:

an envelope (see column 7, lines 60-65, Slater);

an album; and

a box.

7. Regarding Claim 40, Slater discloses a method further comprising:

forming at least a portion of the plurality of images by a non-digital camera (see column 10, lines 32-39, Slater); and

converting the at least a portion of the plurality of images into digital form (see column 10, lines 2-10, Slater).

8. Regarding Claim 41, Slater discloses a method further comprising:

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placing the label on the storage device (see column 7, lines 60-65, Slater); and

placing printed copies of the plurality of images in the storage device (see Fig. 7, Slater).

9. Regarding Claim 42, Slater discloses a method further comprising:

searching the database with a query to locate a printed copy of one image of the plurality of images (see column 6, lines 31-43, Slater);

providing the identifier associated with the one image (see column 6, lines 44-47m Slater) ;

locating the storage container with the label having the identifier (see column 6, lines 45-49, Slater);

searching the storage container for the printed copy of the one image (see column 7, lines 30-35, Salter).

10. Regarding Claim 45, Slater discloses a method further comprising:

searching the database with a query to locate the printed copy of the image (see column 6, lines 31-43, Slater); and

providing the thumbnail representation of the image (see column 10, lines 19-27, Slater).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (US Patent 6,483,570) in view of Reed (US Patent No. 6,426,801).

11. Regarding Claim 39, Slater discloses all of the claimed subject matter as set forth above. However, Slater is silent with regard to the method of forming at least a portion of the plurality of images by a digital camera. However, Reed on the other hand discloses the use of formatting at least a portion of the plurality of images by a digital camera (see column 6, lines 26-32, Reed). It would have been obvious to one of ordinary skill in the art to develop films from digital camera as suggested by Reed, with the motivation of increasing the marketshare and make it accessible for higher verity of customers, which in other words increase the company's revenue.



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*Points of Contact*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 746-9890. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

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Sana Al-Hashemi  
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April 21, 2004

  
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